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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,477	03/08/2001	Thomas Dodt	P20466	4933
7055	7590	05/22/2006	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			JOHNSTONE, ADRIENNE C	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/800,477	Applicant(s) DODT ET AL.	
	Examiner Adrienne C. Johnstone	Art Unit 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6 and 7 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 8-21 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C.

112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 08/955,920, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Specifically, 08/955,920 does not provide support for the subject matter of claims 1-3 and 8-21 for the reasons set forth below.

A. There is no literal support in the parent application original disclosure for the instant claim 1 language.

Applicants have literal support in the parent application for the following:

1) the generic language describing the sound-absorbing insert provided with an acoustically transparent support element exhibiting tensile strength in at least the circumferential direction (specification paragraph 0011 and parent specification p. 3 lines 9-11);

2) the alternative generic language describing the sound-absorbing insert as open-cell foamed material whose pores are oriented predominately in the circumferential direction to provide the insert with tensile strength in the circumferential direction (specification paragraphs 0012-0014, 0024, and 0070 and parent specification p. 3 lines 13-27, p. 5 lines 24-30, and p. 10 line 27 - p. 11 line 9)

3) the subgeneric language describing the sound-absorbing insert provided with an acoustically transparent support element exhibiting tensile strength in at least the circumferential direction (specification paragraph 0011 and parent specification p. 3 lines 9-11) including wrapping the support element over the surface of the sound-absorbing insert that is open to the tire interior such that it covers at least a portion of the insert cross-section (specification paragraph 0015 and parent specification p. 3 line 29 - p. 4 line 1);

4) the alternative subgeneric language describing the sound-absorbing insert provided with an acoustically transparent support element exhibiting tensile strength in at least the circumferential direction (specification paragraph 0011 and parent specification p. 3 lines 9-11) including [layers of] the support element placed at discrete radial distances from each other in the sound-absorbing insert (specification paragraph 0016 and parent specification p. 4 lines 4-9) such as by forming the insert from a ring-shaped strip of sound-absorbing material that is looped around the rim several times, the support element attached to at least the outer side of the strip such that each layer of the strip also contains a support element layer (specification paragraphs 0020-0021 and 0064-0067 and parent specification p. 4 line 29 - p. 5 line 6 and p. 9 line 25 - p. 10 line 13);

5) the species wherein in the sound-absorbing insert provided with an acoustically transparent support element exhibiting tensile strength in at least the circumferential

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direction (specification paragraph 0011 and parent specification p. 3 lines 9-11) the support element is provided as *fibers that are distributed preferably uniformly in the sound-absorbing insert and oriented predominately in the circumferential direction of the tire* (specification paragraphs 0016, 0025-0026, and 0071-0072 and parent specification p. 4 lines 9-12, p. 6 lines 1-13, and p. 11 lines 11-30) which therefore is covered by neither instance of subgeneric language (the fibers preferably uniformly distributed inside the insert are neither wrapped over the surface of the sound-absorbing insert that is open to the tire interior such that it covers at least a portion of the insert cross-section nor placed in layers at discrete radial distances from each other in the sound-absorbing insert);

6) the species wherein in the sound-absorbing insert provided with an acoustically transparent support element exhibiting tensile strength in at least the circumferential direction (specification paragraph 0011 and parent specification p. 3 lines 9-11) the support element is provided as *a woven mesh* (specification paragraphs 0017, 0053-0060, and 0065 and parent specification p. 4 lines 14-18, p. 7 line 25 - p. 9 line 7, and p. 10 lines 1-7) covered by both instances of subgeneric language (the woven mesh can be either wrapped over the surface of the sound-absorbing insert that is open to the tire interior such that it covers at least a portion of the insert cross-section or placed in layers at discrete radial distances from each other in the sound-absorbing insert); and

7) the species wherein in the sound-absorbing insert provided with an acoustically transparent support element exhibiting tensile strength in at least the circumferential direction (specification paragraph 0011 and parent specification p. 3 lines 9-11) the support element is provided as *a perforated foil* (specification paragraphs 0018, 0061, and 0065 and parent specification p. 4 lines 20-23, p. 9 lines 9-14, and p. 10 lines 1-7) covered by both

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instances of subgeneric language (the perforated foil can be either wrapped over the surface of the sound-absorbing insert that is open to the tire interior such that it covers at least a portion of the insert cross-section or placed in layers at discrete radial distances from each other in the sound-absorbing insert).

By contrast, the subgenus language of instant claim 1 requires the sound-absorbing insert to be “coupled to” an acoustically transparent support element “comprising at least one layer of fibers oriented in a circumferential direction” which clearly does not have literal support in the parent application original disclosure: the presence of dependent claims 4 and 5 directed to the woven mesh support element makes clear that the instant claim 1 language encompasses something more than just the originally disclosed woven mesh (otherwise these claims would not further limit claim 1). Note that applicants’ arguments mischaracterize the examiner’s position as requiring literal support for the claim 1 subject matter, which is clearly not the examiner’s position in view of part B below.

B. There is no inherent support in the parent application original disclosure for the instant claim 1 language.

Applicants argue that the subgenus language of instant claim 1 requiring the sound-absorbing insert to be “coupled to” an acoustically transparent support element “comprising at least one layer of fibers oriented in a circumferential direction” is inherently disclosed because the general importance of tensile strength in the circumferential direction of the insert is disclosed and the woven mesh species is disclosed, however this is not the case here because:

1) The test for compliance with the written description requirement of 35 U.S.C. 112 first paragraph is not what would have been *obvious* to one of ordinary skill in the art but what is expressly or inherently *disclosed*. See, e.g., *Lockwood v. American Airlines Inc.*, 41 USPQ2d 1961, 1966 (CAFC

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1997)(“Entitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed. It extends only to that which is disclosed. ... The question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. Rather, a prior application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought. ... A description which renders obvious the invention for which an earlier filing date is sought is not sufficient.”) and *In re Barker and Pebl*, 194 USPQ 470, 474 (CCPA 1977) quoting *In re Winkhaus, Tuschke, and Kampf*, 188 USPQ 129, 131 (“That a person skilled in the art might realize from reading the disclosure that such a step is *possible* is not a sufficient indication to that person that that step is part of appellant’s invention.”).

2) The parent application original disclosure does not include a *representative number* of specific support element embodiments to adequately describe the new subgenus language of instant claim 1 requiring the sound-absorbing insert to be “coupled to” an acoustically transparent support element “comprising at least one layer of fibers oriented in a circumferential direction”. See, e.g., *University of California v. Eli Lilly and Co.*, 43 USPQ2d 1398, 1406.

a) The presence of dependent claims 4 and 5 directed to the woven mesh support element makes clear that the instant claim 1 language encompasses something more than just the originally disclosed woven mesh (otherwise these claims would not further limit claim 1).

b) The only one of the originally disclosed support element examples noted above containing any fibers *in a distinct layer* (as opposed to the short fibers uniformly distributed in the insert material itself, specification paragraphs 0016, 0025-0026, and 0071-0072 and parent specification p. 4 lines 9-12, p. 6 lines 1-13, and p. 11 lines 11-30) is the specific

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woven mesh support element (specification paragraphs 0017, 0053-0060, and 0065 and parent specification p. 4 lines 14-18, p. 7 line 25 - p. 9 line 7, and p. 10 lines 1-7).

c) The originally disclosed generic language describing the sound-absorbing insert provided with an acoustically transparent support element exhibiting tensile strength in at least the circumferential direction (specification paragraph 0011 and parent specification p. 3 lines 9-11) in combination with the originally disclosed embodiment wherein the support element is in the form of a woven mesh (specification paragraphs 0017, 0053-0060, and 0065 and parent specification p. 4 lines 14-18, p. 7 line 25 - p. 9 line 7, and p. 10 lines 1-7) does not adequately describe the particular subgenus of support elements “comprising at least one layer of fibers oriented in a circumferential direction” “coupled to” the sound-absorbing insert for purposes of compliance with the written description requirement of 35 U.S.C. 112 first paragraph because there is no indication in the parent application original disclosure that applicants considered the subgenus structure to be the only characteristic of the woven mesh important in achieving circumferential tensile strength (for example, it may very well be at least as important that the woven mesh has fibers extending around the *entire circumference* of the insert and/or transverse fibers linking together the circumferential fibers in order to provide the requisite degree of tensile strength to the insert) and there are no other originally disclosed support element embodiments sharing the subgenus characteristics that would suggest that applicants were in possession of that subgenus at the time of filing of the parent application. See, e.g., *In re Smith*, 173 USPQ 679, 683-684 (CCPA 1972)(generic disclosure plus species with at least 12 carbon atoms did not support subgenus of at least 8 carbon atoms) and *In re Lukach, Olson, and Spurlin*, 169 USPQ 795, 797 (generic disclosure of small molecular weight ratio plus species of molecular weight ratio 2.6 did not support

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molecular weight ratio 2.0-3.0). This is especially true in view of applicants' statement that "A series of possibilities exist for concrete embodiments of the support elements" (specification paragraph 0017 and parent specification p. 4 line 14), the specific nonfibrous perforated foil support element embodiment (specification paragraphs 0018, 0061, and 0065 and parent specification p. 4 lines 20-23, p. 9 lines 9-14, and p. 10 lines 1-7), and the virtually unlimited and *unpredictable* number of possible support element materials and constructions generically having tensile strength in at least the circumferential direction, including material whose microstructure has been chemically or physically modified to produce the requisite degree of tensile strength in the circumferential direction.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 and 8-21 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Application 0 911 185 A2 (equivalent to prior-filed US Application 08/955,920).

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See paragraph 1 above: the effective filing date for claims 1-3 and 8-21 is March 8, 2001 because these claims are not entitled to the benefit of the filing date of the prior-filed application 08/955,920, however the woven mesh species disclosed in 08/955,920 and its equivalent EP 0 911 185 A2 anticipates the subgeneric claims 1-3 and 8-21 (see for example the case law cited in MPEP 2131.02). Note that the decision of the Board of Patent Appeals and Interferences mailed January 24, 2006 did not decide the issue of whether or not there is support in prior-filed application 08/955,920 for the subject matter in claims 1-3 and 8-21.

Allowable Subject Matter

4. Claims 4 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
5. Claims 6 and 7 are allowed.

See the decision of the Board of Patent Appeals and Interferences mailed January 24, 2006 for reasons for allowance.

Conclusion

6. Note that applicants have clarified that the claim 1 language does *not* include the species wherein the support element is provided as “fibers that are distributed uniformly in the sound-absorbing insert and oriented predominantly in the circumferential direction of the tire” rather than the woven mesh, therefore the indefiniteness rejection of the claim 1 language based on appellants’ previous arguments that the claim 1 language encompassed that species have not been maintained by the examiner. Appellants also do not argue the examiner’s position that the specification paragraph 0067 requires the “at least one side” of the wrapped strip of sound-absorbing material in

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claim 10 to be *at least the radially outer side*, therefore the indefiniteness rejection of claim 10 based on the "at least one side" language has not been maintained by the examiner.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne C. Johnstone whose telephone number is (571) 272-1218. The examiner can normally be reached on Monday-Friday, 10:30AM-7:00PM.


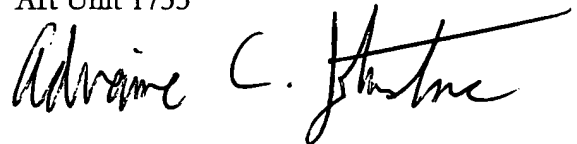
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Adrienne Johnstone

May 19, 2006

Adrienne C. Johnstone
Primary Examiner
Art Unit 1733



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